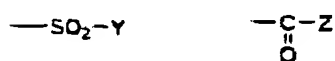


# BEST AVAILABLE COPY

## Remarks

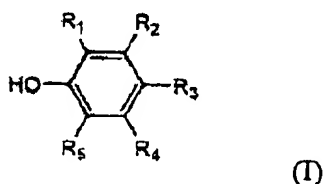
In the Final Office Action of April 12, 2005, the Examiner states "Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hisao et al. (JP-08-133910; see English translation)".

However, Hisao et al. does not disclose bisphenol-based compounds having the following groups

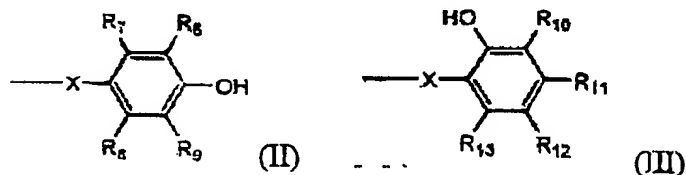


which are claimed in claim 1 of the present invention, because Z of the formula (2) of Hisao et al. described in paragraphs [0010] and [0017 to 0024] is only a hydrogen atom, a halogen atom, or an alkyl group.

In detail, the phenol derivative of Claim 1 in the present invention is represented by formula (I)



wherein R<sub>3</sub> may be formula (II) or (III)



and when R<sub>3</sub> is formula (II), one of R<sub>1</sub>, R<sub>5</sub>, R<sub>6</sub>, and R<sub>9</sub> is selected from the group consisting of



and when R<sub>3</sub> is formula (III), at least one of R<sub>1</sub>, R<sub>5</sub>, and R<sub>10</sub> is selected from the group consisting of



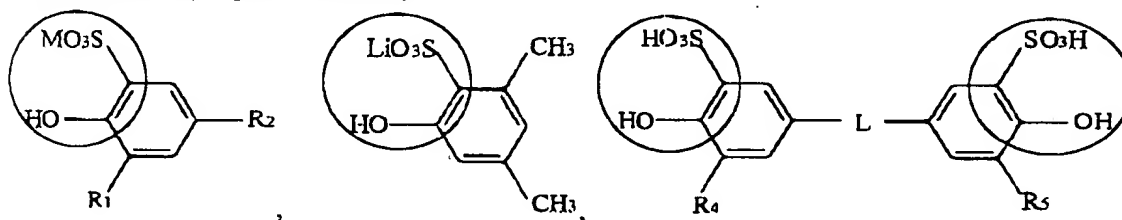
Therefore, because when R<sub>3</sub> is formula (II) or (III), the phenol derivative has

$-\text{SO}_2-\text{Y}$  or  $-\overset{\text{O}}{\underset{\text{O}}{\text{C}}}-\text{Z}$ , the phenol derivative of the present invention must be different from the bisphenol-based compound of Hisao et al., in which Z is a hydrogen atom, a halogen atom, or an alkyl group.

Therefore, Claim 1 of the present invention is not anticipated by Hisao et al. and is novel.

Also, the Examiner states "Claims 2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Toan et al. {US Pat. 5,509,957}".

However, compounds No.1, 3, 4, 6, 7, 9, 15, and 19 -24 in Toan et al. are described as following (emphasis added):



Accordingly, Toan et al. discloses a compound having  $-\text{SO}_2\text{OH}(-\text{SO}_2\text{OM})$  in ortho-position with respect to an  $-\text{OH}$  group on benzene rings.

On the other hand, although the phenol derivative of claims 2 and 4 in the present invention includes  $-\text{SO}_2\text{Y}$  in  $\text{R}_{17}$ ,  $\text{R}_{20}$ ,  $\text{R}_{33}$ , and  $\text{R}_{37}$  of the compound represented by Formula (IV) and (VI), Y is never a hydroxyl group, as defined in claims 2 and 4.

The above argument regarding claim 2 and claim 4 is basically the same argument filed on July 11, 2003. Regarding this argument, in the Final Office Action of April 12, 2005, the Examiner asserts "This argument is not persuasive because variables  $\text{R}_{17}$ ,  $\text{R}_{20}$ ,  $\text{R}_{25}$ ,  $\text{R}_{28}$ ,  $\text{R}_{33}$ , or  $\text{R}_{37}$  can in fact include a hydroxyl moiety".

However, as clearly defined in claims 2 and 4, the phenol derivative of claim 2 and 4,  $-\text{SO}_2-\text{Y}$  may have a hydroxyl group only when it is cyclohexyl, cyclopentyl, benzyl, phenethyl,  $\alpha$ -methylbenzyl, or naphthyl. This means that the  $-\text{OH}$  group of Y of  $\text{R}_{17}$ ,  $\text{R}_{20}$ ,  $\text{R}_{33}$ , and  $\text{R}_{37}$  is never directly bonded to the oxygen atom of the  $-\text{SO}_2-$ . Therefore,  $\text{R}_{17}$ ,  $\text{R}_{20}$ ,  $\text{R}_{33}$ , and  $\text{R}_{37}$  do not include  $-\text{SO}_2\text{OH}$  ( $-\text{SO}_2\text{OM}$ ) described in Toan et al.

Accordingly, the compound of Toan et al. is not the same as the phenol derivative of the present invention, and hence claims 2 and 4 of the present invention are novel.

Moreover, the Examiner states "Claims 2-4, 12-19, and 28-31 are rejected under 35 U.S.C. 103(b) as being unpatentable over Toan et al. {US Pat. 5,509,957}, in view of Klemm et al. {EP 29990 A1; see English abstract}".

Considering the Examiner's rejection of claims 2-4, 12-19, and 28-31 under 35 U.S.C. 103(b) as being unpatentable over Toan et al., in view of Klemm et al., there is no motivation to combine Toan et al. and Klemm et al., because Toan et al. relates to ink compositions for ink-jet printing, and Klemm et al. relates to a medicine dispensing having effects of stopping bleeding astringent and sterilization, which does not relate to ink compositions.

In determining whether a case of obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification. The prior art must provide the motivation to make a change to its own teachings to arrive at the invention under rejection. That is, it is not sufficient that the prior art could be so modified; instead the prior art must teach or suggest that the prior art should be so modified. In addition, it is well-established law in the United States that the motivation to modify the teachings of a reference must come from the references themselves, and cannot be derived from the teachings of the application under examination.

In addition, neither of Toan et al. and Klemm et al. discloses molecular compounds or clathrate. Therefore, it would be not easy for a skilled person in the field to conceive the molecular compound and clathrate of the present invention, which have excellent effects in the technical field.

Accordingly, we believe Claims 2-4, 12-19, and 28-31 of the present patent application should be allowed.

CONCLUSION

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 943-9300 would be appreciated.

Very respectfully,

Dated: 6/1/05



Dennis G. LaPointe  
LaPointe Law Group, P.L.  
P.O. Box 1294  
Tarpon Springs, FL 34688-1294  
(727) 943-9300  
Reg. No. 40,693

Customer No. 24040